



## UNITED STATES DEPARTMENT OF COMMERCE

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SERIAL NUMBER	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/504, 547	07/20/95	PAN	L 2224-0103P

12M2/0107  
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EXAMINER
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KART UNIT	P	PAPER NUMBER
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1204

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DATE MAILED: 01/07/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 26/9 + 27/9/96  This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

## Part II SUMMARY OF ACTION

1.  Claims 1-30 are pending in the application.

Of the above, claims 24-30 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-23 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

## EXAMINER'S ACTION

Serial Number: 08\504547

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Art Unit: 1204

This is in response to the communication filed 16 Sept. and 02 October 1996.

In response to the restriction requirement applicants elected the invention of Group I, claims 1-23 with traverse. Applicants arguments based on the restriction have been carefully considered but are not persuasive to overcome the restriction requirements. The compounds (catalysts) of Group I can be used to catalyze other reactions besides a carbonylation process. Accordingly, the restriction requirement is maintained.

Claims 24-30 are withdrawn from consideration as being directed to non-elected invention.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Serial Number: 08\504547

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Art Unit: 1204

Claims 1-23 rejected under 35 U.S.C. § 103 as being unpatentable over EP 441,446 published 14 August 1991.

The catalysts described and set forth in claims 1-14 of the reference reads on applicants claimed catalysts, and on page 3, lines 7-8 the Group VIII metals used are exemplified.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul J. Killos whose telephone number is (703) 308-0135. The Examiner's normal tour of duty is Mon-Fri. 8:30 a.m. to 5:00 p.m. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1200 receptionist whose telephone number is (703) 308-1235. The Examiner's supervisor Gary Geist, may be reached on (703) 308-1701. Communications may now be transmitted via FAX directly to group 1200. The official group 1200 FAX machine number is (703) 308-4556.

Killos - C. Williams

December 12, 1996

*Paul Killos*  
PAUL J. KILLOS  
PRIMARY EXAMINER  
ART UNIT 1204  
1204